

REMARKS

This amendment is submitted with a request for a two month extension, appropriate fee and a Request for Continued Examination in response to the final Office Action dated September 2, 2005 and the Advisory Action dated November 29, 2005.

Claims 19-40 currently stand rejected. Applicant has amended claims 19, 21 and 38-40 to more particularly distinguish the claimed invention from the cited references. Newly added claims 41-47 have been added to further define patentable aspects of the invention. No new matter has been added by the amendment. Claims 22-25 have been canceled, without prejudice.

In light of the amendment and the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present invention.

Claim Rejections - 35 USC §103

Claims 19, 20, 28-30, 35-36, 38 and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cushion et al. (WO 99/23800, hereinafter "Cushion"). Claims 21-27, 31-34, 37 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cushion in view of Azartash et al. (WO 99/21343, hereinafter "Azartash"). Claims 22-25 have been canceled, without prejudice, thus the rejections of claims 22-25 are now moot.

I. The cited references fail to teach a device having first and second display control functions associated with the closed and open configurations, respectively.

Independent claim 19 recites, *inter alia*, that the display provides a first display control function in the closed configuration, and a second display control function in the open configuration. In other words, independent claim 19 is directed to a device having different operating states in which it controls the display to provide different display control functions depending on whether the device is in the closed configuration or the open configuration.

To the contrary, Cushion includes a cross-switch (34) on the keypad, which is the only key accessible to the user when the device is in the closed position with the first and second parts (10 and 12) folded together. Cushion clearly states that the software in the device controlling the menu and its functions is designed so that when the device is in the closed position, by

selectively operating the cross-switch (34) the user has all the options that are available when the device is in the open position (page 4, lines 10-15). Thus, the device of Cushion provides the same functionality (inherently including displaying of received text) in both the closed and open positions. Accordingly, Cushion fails to teach or suggest that the display provides a first display control function in the closed configuration, and a second display control function in the open configuration as claimed in independent claim 19.

Azartash is directed to a portable telephone device with a see-through flip element allowing a display of the device to be visible when folded. Azartash fails to teach or suggest that the display provides a first display control function in the closed configuration, and a second display control function in the open configuration. Furthermore, Azartash is not cited as teaching such feature.

Since neither Cushion nor Azartash alone teach or suggest that the display provides a first display control function in the closed configuration, and a second display control function in the open configuration as claimed in independent claim 19, any combination of the cited references likewise fails to render independent claim 19 obvious for at least the same reasons described above. It is submitted that independent claim 38 recites substantially similar subject matter to that of independent claim 19 with respect to the device having first and second display control functions associated with the closed and open configurations, respectively, and that independent claim 40 also recites substantially similar subject matter except that the first and second display control functions are recited as displaying received text in a first format and a second format, respectively. Thus, independent claims 38 and 40 are patentable for at least the same reasons as given above for independent claim 19. Claims 20, 21, 26-37 and 39 depend either directly or indirectly from respective ones of the independent claims 19 and 38, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 20, 21, 26-37 and 39 are patentable for at least those reasons given above for independent claim 19.

II. The cited references fail to teach a device that streams text data without repeated user input.

Although independent claim 19 is patentable for at least those reasons described above, Applicant respectfully submits that still further reasons for patentability of independent claim 19 exist. For example, independent claim 19 recites, *inter alia*, the first display control function providing the received text to the user as text which **streams, without repeated user input**, through the visible portion of the display. In other words, the processor controls the display to provide separate control functions corresponding to the open and closed configurations and allows the display to show **streamed** text data while in the closed configuration. Thus, a user can view text **streamed** through the visible portion of the display without a need to scroll through text as would typically be required in order to view a text message on a mobile phone display. It is respectfully submitted that none of the cited references, taken either individually or in combination, teach the above-listed features.

In an exemplary embodiment of the claimed invention, the communication device includes a body, a display and a cover. The cover includes an aperture, which allows the display to be viewed by a user even though the cover is in a closed configuration with respect to the body. The device also includes a processor which controls the display such that, when the cover is in the closed configuration, text is streamed across the display. This streaming of text across the display is contrary to typical well known display techniques which require user interaction to scroll across a text message in order to display the entirety of the text message.

Although the requirements for a *prima facie* case of obviousness are well known to the Examiner, they are stated here for convenience and for completeness of the record for appeal. First, there must be some suggestion or motivation to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the cited references fail to teach or suggest first display control function providing the received text to the user as text which **streams, without repeated user input**, as claimed in independent claim 19. Therefore, all of the claim limitations are not taught and suggested by the cited references as required by MPEP 706.02(j). Thus, a *prima facie* case of obviousness has not been established as required in accordance with MPEP 706.02(j). Therefore, the rejection of claim 19 is respectfully traversed.

Cushion discloses a cellular handheld telecommunications device having first and second parts (10) and (12) connected by hinges (14) and (16) to enable the first and second parts (10) and (12) to be folded or unfolded. The device of Cushion further includes a display (24) disposed in the first part (10) and a cutout (30) disposed in the second part (12) such that, when the device is folded, the display (24) is visible through the cutout (30). Cushion discloses a cross-switch (34) which is accessible when the device is folded. The cross-switch (34) is selectively operated to control the device's menu and give the user all normally available functions (page 4, lines 10-15). Thus, the cross-switch (34) may be operated repeatedly by the user to scroll through text as is well known in the art. In fact, the cross-switch (34) depicted in Figure 3 is an example of the type of joystick-like controller which would be used to scroll through text in such a manner as is well known in the art. Accordingly, it is submitted that Cushion not only fails to teach or suggest that when the device is in the closed configuration the processor provides the received text to the user as text which streams, without repeated user input, through the visible portion of the display as claimed in independent claim 19, but further that Cushion teaches away from streaming text by virtue of its disclosure of a scrolling device in the form of the cross-switch (34).

The Advisory Action has admitted that Cushion does not disclose whether the processor controls the display in the closed configuration with or without user input. However, the Advisory Action goes on to assert that it would have been obvious for a person skilled in the art, at the time the invention was made, within his skills and upon his design preference, to selectively implement Cushion to arrive at such feature. It is respectfully submitted that this assertion of the Advisory Action fails to meet the requirements for establishing a *prima facie* case of obviousness. MPEP 2143.01 states that "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art." In the present case, the Advisory Action fails to point to any explicit or implicit suggestion to modify Cushion from the Cushion reference itself. Applicant respectfully submits that a mere reference to design preference of one skilled in the art does not amount to a suggestion to modify the reference. This

is particularly true where the difference is a significant technical improvement as demonstrated by the claimed invention. Furthermore, Applicant respectfully submits that it cannot be fairly stated that streaming text without repeated user input would have been an obvious modification to one of skill in the art, even if such a skill were within the capability of one of ordinary skill in the art in light of MPEP 2143.01 which states that the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness”.

Accordingly, Cushion fails to teach or suggest that the processor provides the received text to the user as text which **streams**, without repeated user input, through the visible portion of the display as claimed in independent claim 19.

Azartash also fails to teach or suggest that when the device is in the closed configuration a processor provides the received text to the user as text which **streams**, without repeated user input, through the visible portion of the display. Furthermore, Azartash is not cited as teaching such feature.

Since neither Cushion nor Azartash alone teach or suggest that when the device is in the closed configuration the processor provides the received text to the user as text which **streams**, without repeated user input, through the visible portion of the display as claimed in independent claim 19, any combination of the cited references likewise fails to render independent claim 19 obvious for at least the same reasons described above. Claims 20, 21 and 26-37 depend either directly or indirectly from independent claims 19, and thus include all the recitations of independent claim 19. Therefore, dependent claims 20, 21 and 26-37 are also patentable for at least those reasons given above for independent claim 19.

III. The cited references fail to teach a device displaying received text in first and second formats associated with the closed and open configurations, respectively.

Although independent claim 40 is patentable for at least those reasons described above, Applicant respectfully submits that still further reasons for patentability of independent claim 40 exist. For example, dependent claim 40 recites, *inter alia*, in a closed configuration the processor provides the received text to the user in a first format and responsive to movement of

the cover from the closed position to the open position the processor provides the received text to the user in a first format and the first format provides a first quantity of content in a first time period and the second format provides a second quantity of content in the first time period, wherein the second quantity is greater than the first quantity. Cushion discloses no such feature and is not cited as such. Accordingly, Azartash is cited as curing such deficiency by disclosing at page 3, lines 23-27 that the display may be magnified for easy viewing when in the closed configuration. It is respectfully submitted that mechanical magnification of a display having a particular format does not constitute a format change. Rather, such magnification simply alters the way the text is perceived by the user. Furthermore, the claimed invention recites that the first format provides a first quantity of content in a first time period and the second format provides a second quantity of content in the first time period, and that the second quantity is greater than the first quantity. Meanwhile, Azartash fails to teach or suggest any such feature. Accordingly, Azartash fails to teach or suggest both that in a closed configuration the processor provides the received text to the user in a first format and responsive to movement of the cover from the closed position to the open position the processor provides the received text to the user in a first format and the first format provides a first quantity of content in a first time period and the second format provides a second quantity of content in the first time period, wherein the second quantity is greater than the first quantity. Thus, Cushion and Azartash, individually or in combination, fail to teach or suggest that in a closed configuration the processor provides the received text to the user in a first format and responsive to movement of the cover from the closed position to the open position the processor provides the received text to the user in a first format and the first format provides a first quantity of content in a first time period and the second format provides a second quantity of content in the first time period, wherein the second quantity is greater than the first quantity as claimed in independent claim 40. Thus, independent claim 40 contains yet further patentable subject matter over the cited references.

Accordingly, for all the reasons stated above, Applicant respectfully submits that the rejections of claims 19-21 and 26-40 are overcome.

Newly Added Claims

Appl. No.: 10/089,988
Amdt. dated 01/31/2006
Reply to Advisory Action of 11/29/2005

Applicant has added new claims 41-47 to more particularly define aspects of the present invention. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

Appl. No.: 10/089,988
Amdt. dated 01/31/2006
Reply to Advisory Action of 11/29/2005

CONCLUSION

In view of the amendment and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



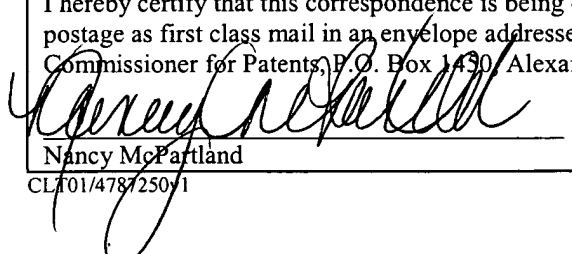
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CLT01/4787250/1